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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,522	10/16/2003	Makoto Nagasato	008312-0306292	6001

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EXAMINER

CAO, ALLEN T

ART UNIT PAPER NUMBER

2652

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/685,522	Applicant(s) NAGASATO, MAKOTO	
	Examiner Allen T. Cao	Art Unit 2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/16/03, 1/5/05, 6/2/05</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The term “can” in claim 1, lines 1 and 3; claim 7, line 2; claim 12, lines 1, 3 and 19; claim 15, line 12 and the phrase “just like” in claim 1, lines 12-13 and in claim 12, line 16 are vague and indefinite because its lack metes and bounds of the claimed invention.

b) The phrase “at least one cartridge holding area, which can prevent contact with the recording surface of the recording medium, when inserting into the recording/playing unit” in claim 12, lines 18-21 is vague and indefinite because it is confusing as to what “prevent contact” to. It is unclear as to what is contacted to the recording medium that the cartridge holding projecting area prevents for.

c) The phrase “a clearance part to define the operating direction of a molding machine” in claim 4, lines 2-3 is vague and indefinite. It is unclear as to what and how “a clearance part to define the operating direction of a molding machine” as set forth in claim 4.

2. Claim 6, 11 and 14-15 are objected to because of the following informalities:

a) The term “the” of the phrase “the hollow space” in claim 15, line 7 should be changed to —a— for avoiding lacking of antecedent basis.

b) The phrase “claim 1” in claim 6, line 1 should be changed to —claim 4— because claim 1 does not disclose “a clearance part”, only claim 4 does.

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c) The phrase "the clearance part" in claim 11, line 3 should be fixed also (see b) above) because neither claim 1 nor claim 8 disclose "a clearance part", only claim 4 does.

d) The phrase "claim 12" in claim 14, line 1 should be changed to —claim 13— because claim 12 does not disclose "notches", only claim 13 does.

Appropriate correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Petruchik et al (US. 4,773,058).

Petruchik et al discloses a disc cartridge 8 having a flat part 12 which includes an opening (the top opening surface of the cartridge 8) to expose the recording surface of a recording medium 6 to be contained, and occupies in a main area (top opening including rails 14-16); a side wall 12a which is formed in one body with the flat part, and contains the disc 6 in the hollow space 13 defined by the flat part; a notch N which is provided in a part of the side wall in one body with the flat part (see figures 5A and 5B); and at least two projection members (22, 22) in the side wall (column 4, line 14 discloses that "the tabs 22 are integral with wall 12a") and almost parallel to the flat part, which "can prevent the recording medium from going out of the hollow space and

contacting the recording surface of the recording medium, with the recording medium contained in the hollow space", all as set forth in claimed language of the claims 1, 12 and 15.

Petruchik et al also discloses a handling projection area 32 which "extends" parallel to the main wall from the side wall opposite to the predetermined direction when inserting into the recording/playing unit 2 (see figures 4B and 5A-5B), as recited in claims 1 and 12.

Petruchik et al does not clearly recited that the cartridge holding projection area "can prevent contact with the recording surface of the recording medium, when inserting into the recording/playing unit" as recited in claim 12.

However, Petruchik et al discloses that the cartridge projection area 32 are attached and pressed the disc to the disc holding member 22, thus its maintains the disc in one secured position when inserting into the recording/unit 2 which inherently shows that the cartridge projection area preventing the recoding medium of the disc being contacted. Here, Applicant does not disclose how the cartridge projection area can be protected the recording medium surface.

Regarding claim 2, Petruchik et al discloses that the main wall has a window for an optical pickup head and a spindle motor (see figures 9A-9D).

Regarding claim 3, Petruchik et al discloses there are more than one disc drop prevention member is provided (22, 22).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruchik et al.

Petruchik et al discloses that the main wall, the disc drop prevention member and the clearance part (the clearance part here is considered as rails 14 and 15) are molded at the same time (column 4, lines 14-16). Petruchik et al does not disclose that the handling projection area is also molded at the same time with the main wall, the disc drop prevention member and the clearance part as set forth in claims 4 and 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handling projection area of Petruchik et al is also molded at the same time with the main wall, the disc drop prevention member and the clearance part through an obvious manufacturing technique for ease in manufacturing in order to save manufacturing cost and time. Additionally, it is not found to be persuasive as a process limitation should only be accorded weight to the extent that it affects the structure of the completed a disk cartridge since claims are directed to a "disc cartridge", per se. Furthermore, it should be noted that "[d]etermination of patentability in 'product-by-process' claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior art product was made by a different process", In re Thorpe, et al., 227 USPQ 964 (CAFC 1985). It should also be

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noted that a "[p]roduct-by process claim, although reciting subject matter of claim in terms of how it is made, is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations", In re Hirao and Sato, 190 USPQ 685 (CCPA 1976).

7. Claims 7-11 and 13-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

a) The prior art of record neither discloses nor suggests a disk cartridge as set forth in claim 1 having that "the disc drop prevention member can be temporarily deformed when the optical disc is inserted or draw out" as recited in claim 7.

b) The prior art of record neither discloses nor suggests a disk cartridge as set forth in claim 1 having that "a preventive or coating to prevent undesired damage to the optical disc, provided in the side of the disc drop prevention member and the handling projection area, facing the optical disc" as recited in claim 8.

c) The prior art of record neither discloses nor suggests the disc cartridge as set forth in claim 12 having that "at least two notches are provided in the side wall in the almost orthogonal direction, and at least one notch is directed to the direction almost equal to the length direction of the opening" as recited in claim 13.

d) The prior art of record neither discloses nor suggests the disc cartridge as set forth in claim 12 (or claim 13) having that "the cartridge holding projection area is

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provided opposite to the notches on the side wall reverse to the direction in which the notches are provided, taking a predetermined position of the opening as a point of symmetry" as recited in claim 14.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen T. Cao whose telephone number is (571) 272-7569. The examiner can normally be reached on Mon - Thurs (7:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Allen Cao
Primary Examiner

AC
June 9, 2005